UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/425,766	04/19/95	GREENE R	017220.0115

QM61/0330

BAKER & BOTTS
2001 ROSS AVENUE
DALLAS TX 75201-2980

EXAMINER	
TINKER,S	
ART UNIT	**PAPER NUMBER**
3744	18

DATE MAILED: 03/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

#18

Office Action Summary	Application No. 08/425,766	Applicant(s) Greene et al
	Examiner Susanne Tinker	Group Art Unit 3744

☒ Responsive to communication(s) filed on *Jan 19, 1999* .

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-20* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-20* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Reissue Applications - Recapture

Claims 1-20 are rejected under the equitable Recapture Doctrine as set forth in MPEP 1412.02. A synopsis of the Recapture Doctrine, especially in light of the recent C.A.F.C. decision in Hester Industries Inc. v. Stein Inc., 46 USPQ2d 1641 (1998), and how it applies to this application follows.

If a patentee tries to recapture what he/she previously surrendered in order to obtain allowance of original patent claims, that deliberate withdrawal or amendment cannot be said to involve the inadvertence or mistake contemplated by 35 USC 251 and is not an error of the kind which will justify the issuance of a reissue patent which included the matter withdrawn. The **recapture rule** bars a patentee from acquiring, through reissue, claims that are of the same scope or of broader scope than those claims that were canceled from the original application. In this regard, addition of narrowing limitations to a claim to overcome prior art is considered the full equivalent of cancellation of the claim and substitution of a narrower scope claim to overcome the prior art. See *Mentor Corp. V. Coloplast Inc.*, 27 USPQ2d 1521 (Fed. Cir. 1993).

However, the **recapture rule** will not bar a patentee from securing a reissue claim that is broader in a material respect than a canceled claim when the reissue claim is also narrower than the canceled claim in a way that is material to the "error" sought to be corrected by reissue. *Patacell v. U.S.*, 12 USPQ2d 1440 (U.S. Claims Court 1989). The recapture rule is based on the premise that when a patent applicant seeks to secure a patent by responding to a rejection of a claim by canceling or narrowing the scope of the claim, the applicant's intent is normally presumed. I.e., that the claim was canceled or narrowed based on a deliberate judgment that the claim as originally drafted was unpatentable. I necessarily follows that a deliberate judgment that a claim is unpatentable would constitute a deliberate judgment that a broader claim is also unpatentable. But, when the reissue claim is narrower than the canceled claim in a material respect, a similar conclusion as to the patentee's intent and, therefore, as to the absence of "error" cannot be made exclusively on a comparison of the reissue claim with the canceled claim. The fact that a particular claim is unpatentable over prior art does not mean that a claim that is narrower in some respect but broader in other respects also would be unpatentable. The addition of a particular limitation can result in an otherwise unpatentable claim becoming patentable. Therefore, one cannot assume that when an applicant canceled a claim that the applicant made a deliberate judgment that a second claim that is narrower in a certain respect and of the same or broader scope than the canceled claim is also unpatentable.

Thus, when a reissue claim is narrower than the canceled claim in a way that is material to the alleged "error" supporting reissue, it is not possible to conclude from a comparison of claim scope alone that no "error" was involved in the patentee's failure to include a claim of the general scope of the reissue claim of the original patent. Based on this analysis, the Court of Claims held that where, as in this case, the reissue claim was not only broader in some aspects , but narrower than the canceled patent claim to which it corresponds **in a way that is material to the "error" sought to be corrected by reissue**, the recapture rule should not bar that reissue claim.

In Hester Industries Inc. v. Stein Inc., the C.A.F.C. extended the recapture doctrine to not only apply in cases where applicant has made amendments to claims in the original prosecution indicating critical subject matter, but also to apply to situations where applicant made arguments that subject matter included in the claims is critical. Id. at 1641. Such arguments, even if not accompanied by amendment, can give rise to a finding that the subject matter has been surrendered. The court in Hester held that the equitable principles serving as a foundation for estoppel notions apply equally to the context of recapture.

Applying these principles to the facts of this reissue application:

Applicant seeks to remove the following language from claim 1:
a liquid filter for capturing said particulate matter contained in said fired exhaust and for chemically treating said fire exhaust gases to reduce the quantity of CO, NO, and SO contained in said fired exhaust.

Applicant also seeks to remove similar language from claim 15, the only difference being the particular compounds removed from the exhaust gases.

However, the removal of this language is barred by the equitable "recapture" doctrine when viewed in light of Hester. In the patent sought to be reissued, the patentee argued that this claim language sought to be removed rendered the claims patentable over the prior art cited and applied in the rejection of those claims.

In the patent file, paper No. 5, filed August 19, 1991, on page 4, the patentee argued that the prior art failed to teach or mention a liquid filter arrangement as described and claimed by applicants, in that it did not mention a chemical treatment to reduce the quantity of CO, NO, SO, HCl or SO_2 as is required by applicant's claims. On page 5 of that paper, as Applicant has pointed to in his response filed January 19, 1999, the patentee's contention was that the references omitted ***critical*** features of Applicant's invention. The patentee continued on to discuss that one of the features not included in the references was the liquid filter element. Such an argument leads to the conclusion that the patentee believed the liquid filter element was indeed a critical feature of his invention. As discussed previously, Hester, with its underlying rationale grounded in notions of estoppel, bars the removal of any elements that were argued by the

patentee as being critical to the invention. Clearly, as evidenced by the passage noted above and as Applicant has included in his response to the previous rejection, the liquid filter element was deemed critical to the invention originally filed.

Furthermore, in the patent file in the Appeal Brief filed 10/29/92, applicant also argued the liquid filter element being a novelty of the patented invention which distinguishes it from the prior art.

Thus, applicant is seeking to "recapture" subject matter which was surrendered during the original prosecution of the claims. This is improper and cannot be permitted.

Response to Arguments

Regarding applicant's argument with respect to the examiner's comments in the reasons for allowance as not the type of estoppel covered by Hester, the examiner accepts Applicant's argument and hereby withdraws the rejection based on that ground.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanne Tinker whose telephone number is (703) 308-2637.

Art Unit: 3744

SCT

March 17, 1999

HENRY A. BENNETT
SUPERVISORY PRIMARY EXAMINER
TC - 3744